

### **REMARKS**

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1 and 3-6 are presently active in this case. The present Amendment amends Claims 1 and 3-4, cancels Claim 2 and adds new Claims 5-6.

The outstanding Office Action rejected Claim 4 under 35 U.S.C. § 112, second paragraph, as indefinite. Claims 1 and 3-4 were rejected under 35 U.S.C. § 102(e) as anticipated by Yamane et al. (U.S. Patent No. 6,447,325, herein referred to as "Yamane '325"). Claim 2 was rejected under 35 U.S.C. § 103(a) as unpatentable over Yamane '325 in view of Yamane et al. (U.S. Patent No. 6,494,723, herein referred to as "Yamane '723").

In order to vary the scope of protection recited in the claims, new dependent Claims 5-6 are added. Claim 5 recites that the press contact terminal includes an electric wire slit groove in the press contact edge portion.<sup>1</sup> Claim 6 recites that an edge of the electric wire slit groove is configured to cut an insulating outer sheath of an electric wire inserted into the electric wire slit groove.<sup>2</sup> New Claims 5-6 find support in the disclosure as originally filed and therefore are not believed to raise a question of new matter.<sup>3</sup>

In response to the rejection of Claim 4 under 35 U.S.C. § 112, second paragraph, Claim 4 is amended for clarification. In view of the amendment to Claim 4, it is believed that Claim 4 is definite and no further rejection on that basis is anticipated. If, however, the Examiner disagrees, the Examiner is invited to telephone the undersigned who will be happy to work with the Examiner in a joint effort to derive mutually acceptable language.

In response to the rejection of Claims 1 and 3-4 under 35 U.S.C. § 102(e), independent Claim 1 has been amended to recite "wherein the tab portion of the press contact

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<sup>1</sup> See Applicant's Specification, for example, at page 8, lines 22-24.

<sup>2</sup> See Applicant's Specification, for example, at page 11, line 25 to page 12, line 4.

<sup>3</sup> See MPEP 2163.06 stating that "information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter."

terminal further includes: a main body located in the obverse cover and the reverse cover, a first tab portion provided on a first side of the main body and positioned so that a portion of the first tab portion is protruded from the obverse cover arranged on the wiring board, a second tab portion provided on a second side of the main body and positioned so that a portion of the second tab portion is protruded from the reverse cover arranged on the wiring board, a first groove provided between the main body and the first tab portion, and a second groove provided between the main body and the second tab portion, wherein the press terminal is configured to selectively have a first configuration where both the first tab portion and the second tab portion are protruded, a second configuration where only the first tab portion is protruded while the second tab portion is separated from the main body by cutting the second groove, and a third configuration where only second tab portion is protruded while the first tab portion is separated from the main body by cutting the first groove.”

The amendment is supported by Applicant’s specification for example from page 10, line 7 to page 11, line 17, as well as in Fig. 7A-7C and therefore does not raise a question of new matter. In light of the amendment to independent Claim 1, the rejection is believed to be overcome and Applicant respectfully requests reconsideration of this rejection.

Briefly recapitulating, Applicant’s invention relates to a connection box including a wiring board configured to have a first electric wire arranged on an obverse surface and configured to have a second electric wire arranged on a reverse surface. A press contact terminal is configured to press a press contact edge portion onto one of the first and second electric wires from a side where the wire is arranged. Further, the press terminal is configured to selectively have (1) a first configuration, where both the first tab portion and the second tab portion are protruded, (2) a second configuration, where only the first tab portion is protruded while the second tab portion is separated from the main body by cutting the second groove, and (3) a third configuration, where only second tab portion is protruded

while the first tab portion is separated from the main body by cutting the first groove.

According to Applicant's Claim 1, the press terminal can have three configurations, by remaining or cutting the first/second tab portion from the main body at associated groove.<sup>4</sup>

Turning now to the applied prior art, Yamane '325 does not teach the claimed combination of features, in particular, the claimed first, second and third configurations, selectively protruding either the first tab portion, the second tab portion or both of the first and second tab portions. Yamane '325's Fig. 1, 6A and 6B disclose a external input/output terminal (Fig. 1) or a jumper terminal 20 (Fig. 6A and 6B) having a plurality of compression blades 20a formed in the crosswise direction of pitch P1. In particular, Fig. 1 of Yamane '325 shows the input/output terminals 18 and 19 as well as the electric wires *on the same side* of the insulating plate. Additionally, Fig. 6B of Yamane '325 shows that the wire 15 and the jumper terminal 20 are arranged *on the same side* of the wire circuit board 16.

Yamane '325's invention *does not have the freedom to select three different configurations* (1), (2) and (3) for the press terminal. Input/output terminals on the same side of the insulating plate, as taught by Yamane '325, *are not* press terminals configured to selectively have a first, second and third configuration. Accordingly, Applicant respectfully traverses, and requests reconsideration of, the rejection of Claims 1 and 3-4 based on the Yamane '325 patent.<sup>5</sup>

In response to the rejection of Claim 2 under 35 U.S.C. § 103(a), Applicant traverses the rejection. However, in the spirit of moving the prosecution of the application forward, Claim 2 has been cancelled. Accordingly, the rejection under 35 U.S.C. § 103(a) is now moot.

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<sup>4</sup> See Applicant's Specification, for example in Figures 7A-7C.

<sup>5</sup> See MPEP 2142 stating, as one of the three "basic criteria [that] must be met" in order to establish a *prima facie* case of obviousness, that "the prior art reference (or references when combined) must teach or suggest all the claim limitations," (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

Further, regarding amended Claim 3, Yamane '723 fails to reach or suggest this feature. That is, with response to Fig. 7 of Yamane '723, the press contact edge portion 1034 is not arranged at a right angle to the main body 1031 of the terminal 1030.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1, 3-6 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicant's undersigned representative at the below listed telephone number.

Respectfully submitted,  
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